REMARKS

Claims 1-9, 11-16 and 18-23 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-9, 11-16 and 18-23 Under 35 U.S.C. §101

Claims 1-9, 11-16 and 18-23 stand rejected under 35 U.S.C. §101 as because it is alleged the claimed invention is directed to non-statutory subject matter. This rejection should be withdrawn for at least the following reasons. The subject claims produce a useful, concrete and tangible result.

> Because the claimed process applies the Boolean principle [abstract idea] ***to produce a useful, concrete, tangible result*** ... on its face the claimed process comfortably falls within the scope of §101. *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358. (Fed. Cir. 1999) (Emphasis added); *See State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed.Cir.1998). The inquiry into patentability requires an examination of the contested claims to see if the claimed subject matter, as a whole, is a disembodied mathematical concept representing nothing more than a "law of nature" or an "abstract idea," or if the mathematical concept has been ***reduced to some practical application rendering it "useful."*** *AT&T* at 1357 *citing In re Alappat*, 33 F.3d 1526, 31 1544, 31 U.S.P.Q.2D (BNA) 1545, 1557 (Fed. Cir. 1994) (emphasis added).

Independent claims 1, 11, 14, and 21 produce one or more useful, concrete and tangible results. In particular, independent claim 1 (and similarly, independent claims 11, 14, and 21) recites: *a learning component that* ***generates non-standardized data that relates to a split in a decision tree****; and a scoring component that* ***scores the split as if the non-standardized data at a subset of leaves of the decision tree had been shifted and/or scaled****, the non-standardized data virtually shifted through omission of a matrix operation*. It is submitted that the foregoing recitation provides a number of useful, concrete and tangible results. Specifically, generating non-standardized data relating to a

split in a decision tree; and scoring the split as if the non-standardized data at a subset of leaves of the decision tree had been shifted and/or scaled.

According to *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), the legal standard set forth by the Federal circuit for determining whether claims are directed towards statutory subject matter is whether the claims can be applied in a practical application to produce a useful, concrete and tangible result. It is the result of the claims as applied in a practical application that is germane to the determination of whether the claims are directed towards statutory subject matter, not whether the underlying means by which the result is effectuated that should be tangible, as the Examiner intimates. It is submitted that the subject claims clearly meet the aforementioned legal standard wherein non-standardized data that relates to a split in a decision tree is generated and the split is scored as if the non-standardized data at a subset of leaves of the decision tree had been shifted and/or scaled. Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 1-8, 11-16 and 18-23 Under 35 U.S.C. §103(a)

Claims 1-8, 11-16 and 18-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hulten *et al.* (US 2004/0243548) in view of Chickering *et al.* ("Efficient Determination of Dynamic Split Points in a Decision Tree" , Proceedings of the IEEE International Conference of data Mining, November 29 – December 2, 2001). Withdrawal of this rejection is requested for at least the following reason. Hulten *et al.* is not a citable reference with respect to the subject application. The following is a quotation from 35 U.S.C. §103(c), which forms at least on basis for withdrawal of all rejections in the Office Action:

> (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

It is respectfully submitted that Hulten *et al.* qualifies as art under 35 U.S.C. §102(e), and the subject matter disclosed by Hulten *et al.* and applicants' claimed invention were under an obligation of assignment to Microsoft Corporation at the time the invention was made. Therefore, in accordance with 35 U.S.C. §103(c), Hulten *et al.* is not a citable reference with respect to the subject application. Accordingly, this rejection should be withdrawn.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063[MSFTP485US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/
Himanshu S. Amin
Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731